



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,488	11/05/2001	Siegfried K. Holz	P-1783	5623

7590 01/27/2006

Charles J. Prescott
Charles J. Prescott, P.A.
Suite 115
2033 Wood Street
Sarasota, FL 34237-7926

EXAMINER

GLASS, RUSSELL S

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 01/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/008,488	Applicant(s) HOLZ, SIEGFRIED K.	
	Examiner Russell S. Glass	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>3/20/03</u> . | 6) <input type="checkbox"/> Other: _____ |

01

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Joao, (U.S. 6,283,761).

2. As per claims 2 and 5, Joao discloses a method of preparing and fulfilling a medication prescription written by a physician for a patient at the time of physical examination comprising the steps of:

A. providing a personal memory card (PMC) established for the benefit of, and carried by the patient, said PMC configured to include a stored memory including the patient's personal information, consulting physician information, accessible pharmacy information, medical history, insurer information and an authentication code; (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line 7-col. 27, line 8; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12)(describing all claimed information as being stored and processed within main database, and being transferable for storage and/or processing

Art Unit: 3626

and updating to periphery P.D.A. devices and I.D. cards via internet. Security and confidentiality is a pertinent function of the referenced system and the reference discloses bar or bard codes for all pertinent functions, i.e. authentication code).

B. reading said stored memory into a first PMC reader/writer from said PMC and viewably presenting said stored memory on a personal digital assistant (PDA) in conjunction with a physical examination of the patient by the physician, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12);

C. modifying said stored memory of said PMC by the physician via entry on said PDA to include new medication prescriptions and additional medical history to form an updated stored memory, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12);

D. reading said updated stored memory of said PMC via a second PMC reader/writer into to an office computer of the physician, said office computer configured to electronically transfer said updated stored memory to a remotely located central host server, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12)(reference discloses that all system components can have PMC reader/writers);

Art Unit: 3626

E. transferring said updated stored memory to the host server by the Internet, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line 7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12);

F. transmitting a prescription fulfillment request electronically by said host server for new prescriptions contained within said updated stored memory to one of the accessible pharmacies, said host server configured to store said updated stored memory and for electronically transmitting said request, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line 7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12);

G. transmitting a confirmation electronically from one of the pharmacies selected in step F back to said office computer advising that any new prescriptions are fulfilled, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line 7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12)(notification of the occurrence of an event is considered to be transmitting a conformation).

H. electronically transmitting appropriate insurer information by said host server corresponding to the examination and new prescriptions, (Joao, col. 2, line 63-col. 4, line 33; col. 7, lines 16-23; col. 8, line 31; col. 16, line 38 - col. 20, line 27; col. 26, line 7-col. 27, line 8; col. 31, line 10-col. 32, line 45; col. 33, lines 26-37; col. 34, line 43-col. 35, line 10; col. 39, lines 37- col. 40, line 12).

3. As per claims 1,3, 4 and 6, these system claims contain essentially the same limitations as corresponding method claims 2 and 5 and are therefore rejected on the same basis as claims 2 and 5. The citations applied against method claims 2 and 5 are hereby incorporated against claims 1,3, 4 and 6 by reference.

Furthermore, system claims 1, 3, 4 and 6 contain multiple statement of intended use that fail to further limit the disclosed systems. For example, claim 1 discloses a PMC including a modifiable stored memory including a patient's personal information, consulting physician information, accessible pharmacy information, medical history, insurer information and an authentication code. The listed information claimed as stored on the modifiable stored memory disclose the intended use of the system and, therefore, fail to further limit the claimed system. System claims 1, 3, 4 and 6 are replete with similar intended use limitations that fail to limit the claimed subject matter.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is as follows: Morey, (U.S. Pub. 2005/0182656); Edelson et al., (U.S. 5,737,539); Mayaud, (U.S. 5,845,255); and, Josh Fisher and Rosemary Wang, *The Cure Is In Hand, Bringing Information Technology To Patient Care*, W.R. Hambrecht & Co., October 2000, pp. 1-78.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell S. Glass whose telephone number is 571-272-3132. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 571-272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RSG
12/16/05

R. S. G.


C. LUKE GILLIGAN
PATENT EXAMINER